

# PATENT COOPERATION TREATY

From the  
INTERNATIONAL SEARCHING AUTHORITY

To:  
JAMES D. HAMILTON  
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT,  
P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

RECEIVED:  
OBLON, SPIVAK, MCCLELLAND  
MAIER & NEUSTADT, P.C.

**PCT** DOCKETING DEPT.

Initials/Date Docketed: \_\_\_\_\_

Type of Resp(s): \_\_\_\_\_

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

Date of mailing  
(day/month/year)

**19 MAR 2007**

Applicant's or agent's file reference

275482WO

FOR FURTHER ACTION

See paragraph 2 below

International application No.

PCT/US06/32808

International filing date (day/month/year)

22 August 2006 (22.08.2006)

Priority date (day/month/year)

22 August 2005 (22.08.2005)

International Patent Classification (IPC) or both national classification and IPC

IPC: A43B 13/00( 2006.01),1/10( 2006.01)

USPC: 36/97.102

Applicant

WHITE, JAY

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☒ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

## 2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/ US  
Mail Stop PCT, Attn: ISA/US  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
Facsimile No. (571) 273-3201

Date of completion of this opinion

24 January 2007 (24.01.2007)

Authorized officer

Marie Patterson

Telephone No. 703-308-1148

Form PCT/ISA/237 (cover sheet) (April 2005)

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/US06/32808

**Box No. 1 Basis of this opinion**

1. With regard to the **language**, this opinion has been established on the basis of:

- ☒ the international application in the language in which it was filed  
☐ a translation of the international application into \_\_\_\_\_, which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1(b)).

2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:

a. type of material

- ☐ a sequence listing  
☐ table(s) related to the sequence listing

b. format of material

- ☐ on paper  
☐ in electronic form

c. time of filing/furnishing

- ☐ contained in the international application as filed.  
☐ filed together with the international application in electronic form.  
☐ furnished subsequently to this Authority for the purposes of search.

3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

4. Additional comments:

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/US06/32808

**Box No. IV Lack of unity of invention**

1. ☒ In response to the invitation (Form PCT/ISA/206) to pay additional fees the applicant has, within the applicable time limit:
- ☐ paid additional fees
  - ☐ paid additional fees under protest and, where applicable, the protest fee
  - ☐ paid additional fees under protest but the applicable protest fee was not paid
  - ☒ not paid additional fees
2. ☐ This Authority found that the requirement of unity of invention is not complied with and chose not to invite the applicant to pay additional fees.
3. This Authority considers that the requirement of unity of invention in accordance with Rule 13.1, 13.2 and 13.3 is
- ☐ complied with
  - ☒ not complied with for the following reasons:  
See the lack of unity section of the International Search Report (Form PCT/ISA/210)

4. Consequently, this opinion has been established in respect of the following parts of the international application:

- ☐ all parts.
- ☒ the parts relating to claims Nos. 1-23

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

International application No.  
PCT/US06/32808

**Box No. V Reasoned statement under Rule 43 bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

**1. Statement**

Novelty (N)	Claims <u>5-8, 19, 21, and 22</u>	YES
	Claims <u>1-4, 9-18, 20, and 23</u>	NO
Inventive step (IS)	Claims <u>7 and 8</u>	YES
	Claims <u>1-6 and 9-23</u>	NO
Industrial applicability (IA)	Claims <u>1-23</u>	YES
	Claims <u>NONE</u>	NO

**2. Citations and explanations:**

Claims 1-4, 9-12, and 23 lack novelty under PCT Article 33(2) as being anticipated by Clark (2002/0088145).

Claims 1, 11, 15-18, and 20 lack novelty under PCT Article 33(2) as being anticipated by Gasparovic (6189239).

Claims 1-4, 9, and 15-17 lack novelty under PCT Article 33(2) as being anticipated by Marrone (2002/0078591).

Claims 5 and 6 lack an inventive step under PCT Article 33(3) as being obvious over Clark in view of LaDuca (6745498). Clark shows a shoe with sole segments with deformable members therebetween (108 and 110), and upper segments (86) with elastic segments therebetween (88) substantially as claimed except for the exact location of the elastic segments. LaDuca teaches providing elastic segments (50) in an upper which are located as claimed. It would have been obvious to place the elastic segments as taught by LaDuca in the shoe of Clark to provide a comfortable, and easily expanded upper.

Claims 1, 12-14, and 23 lack novelty under PCT Article 33(2) as being anticipated by Issler (2005/0150134).

Claims 19, and 21 lack an inventive step under PCT Article 33(3) as being obvious over Gasparovic in view of Clark. Gasparovic shows a shoe substantially as claimed except for a rigid member between the sidewalls. Clark teaches providing a rigid member (102 or 130). It would have been obvious to provide a rigid member as taught by Clark in the shoe of Gasparovic to provide support and structure and stability to the shoe.

Claims 7 and 8 meet the criteria set out in PCT Article 33(2)-(3), because the prior art does not teach or fairly suggest the exact contour lines of an elastic portion of an upper in addition to a sole with deformable members as claimed.

Claims 1-6 and 9-23 meet the criteria set out in PCT Article 33(4), and thus meet industrial applicability because the subject matter claimed can be made or used in industry.